

Remarks

The amendments to claims 1, 3, and 4

Examiner will immediately see that the amendments add no new matter. The use of *any* in line 10 of amended claim 1 makes it clear that receipt of the comment is a necessary but
 5 not necessarily sufficient condition for obtaining the CME credit. The amendments to claims 3 and 4 have the same purpose

Traversal of the rejection of claims 1 and 2 under 35 U.S.C. 102

The problem with Examiner's rejection is that it ignores the fundamental requirement for a
 10 rejection under 35 U.S.C. 102. As set forth at MPEP 2131:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
 15 (MPEP rev 3, Aug. 2005, p. 2100-76)

The Telemedicine reference does not satisfy this requirement.

The failure of the Telemedicine reference to show the limitations of claim 1

Telemedicine is a 1996 survey of the new possibilities that the improvements in
 20 information processing and telecommunications which were taking place in the 1990's offered the medical profession. Among the possibilities considered in the survey are “the transmission of health care information and information on education and administrative services” (p.1, col. 1, bottom) and the use of “two-way, interactive telecommunications video systems to examine patients from remote locations, to facilitate medical
 25 consultations, and to train health care professionals” (p.1, col. 2, bottom). Further discussed are the uses of the technology for rural hospitals and health providers (page 3, col. 1, top) and the University of Washington's use of telecommunications technology to overcome distance with regard to medical education, delivery of health care, and conferences among providers (page 4, col. 2, middle). There is also a discussion of the
 30 difference for licensing purposes between using telecommunications technology to provide care directly to a patient from an out of state location and using the technology for consultations between doctors. (page 14, col. 2, top) Implications for medical practice of

live and store-and-forward telecommunications interactions are discussed at page 19, col. 1, beginning in the second paragraph.

The problem with all of this disclosure is that, as might be expected from the nature of
5 Telemedicine, there is no detailed disclosure of particular uses of telecommunications in medicine. As set forth above, however, a rejection of a claim under 35 U.S.C. 102 requires that the reference that is serving as the basis of the rejection disclose *every limitation* of the claim being rejected. Telemedicine provides no such disclosure with regard to the method of Applicants' claim 1. As set forth in the claim's preamble, Applicants' claim 1 is directed
10 to "a method of providing continuing medical education credit". The reference discloses the use of telecommunications technology for continuing medical education, but discloses *nothing whatever* about using the telecommunications technology to provide continuing medical education credit.

15 As further set forth in the preamble, the "continuing medical education credit" is provided under very particular circumstances: it is provided "to a first physician who has been engaged in consultation with a second physician via an intermediary". Finally, the steps are "performed in the intermediary". Again, the reference discloses that telecommunications technology may be used for consultations between physicians, but
20 *nothing whatever* about such consultations taking place via *any* intermediary, let alone one that is connected by a telecommunications system to both the first and second physicians.

The environment set up by the preamble is referred to repeatedly in the steps of the method, and thus must be taken into account in interpreting the claim. Thus, the "comment" of the
25 first method step is "made with regard to the consultation" and "received via the telecommunications system from the second physician". Further, in the second step, the comment is provided "to a medical information specialist in the intermediary" and the medical information specialist "record[s] any continuing medical education credit resulting from the consultation represented by the comment by recording the resulting continuing
30 medical education credit in a database accessible from the intermediary". Clearly, a reference which discloses nothing about providing continuing education credit or about consultations via an intermediary *cannot* disclose anything about a "method of providing

continuing medical education credit” whose method steps are “performed in the intermediary”. Since that is the case, Telemedicine does not anticipate the claim and the rejection of the claim under 35 U.S.C. 102 is without basis.

5 *Rebuttal of Examiner’s arguments in the Office action of 10/18/2005*

Beginning at the bottom of page 6 of her Office action, Examiner attempts to deal with the above problems by noting first that the reference refers to a number of networks that offer CME credits; however the reference discloses *nothing* about methods for giving the credits, which is what claim 1 addresses. Examiner then finds the “intermediary” disclosed in
10 MedVision, which markets “software that enables family physicians and specialists to exchange stored video images and medical records”, but it would not appear that MedVision is acting as an “intermediary” in the sense required by the claim. Examiner further cites the MEDNET health care communications network as being the intermediary. It is clear from the disclosure that MHDI permits exchanges of all kinds of information, but
15 again there is no disclosure of the information exchanges set forth in Applicants’ claim, namely the exchanges between the first and second physicians via the intermediary during the consultation, the exchange between the second physician and the intermediary with regard to the comment, the provision of the comment to the medical information specialist, or the recordation of the MCEC by the medical information specialist.

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Examiner’s discomfort with the logic of her arguments becomes apparent when she states at the end of the arguments,

25 Furthermore, the courts have stated that if a prior art device in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. (page 8, first paragraph)

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The problem with this argument is that as set forth above, the reference provides a general disclosure of ways in which telecommunications systems have been used to communicate medical information, but very little disclosure of particular ways of performing such communications and no disclosure at all of many of the limitations of Applicants’

particular method. If Telemedicine is taken to disclose a device that inherently performs the steps of Applicants' particular method, the reference must also be taken to disclose a device that inherently performs the steps of all other methods of using telecommunications systems to communicate medical information. As any Examiner who is employed in
5 Group 3600, E-commerce, must understand, such a position is untenable.

Patentability of the dependent claims in their own rights

Continuing with claim 2, Telemedicine discloses nothing about the use of an intermediary with a medical information specialist in a consultation between doctors, and can thus
10 disclose nothing about the additional steps performed in the intermediary in the claim. Claim 2 is thus patentable in its own right over Telemedicine.

With regard to claims 3 and 4, Examiner finds the added limitations in Abrahamson. Applicants respectfully submit that Abrahamson teaches nothing beyond the use of a
15 computer system to give and grade examinations. The added limitations of claims 3 and 4, however, are added to the contexts provided by claims 2 and 1 respectively, and because Telemedicine does not disclose all of the limitations of those contexts and Abrahamson discloses nothing further regarding the limitations that Telemedicine does not disclose, the combination of the reference does not disclose all of the limitations of claims 3 and 4.
20 Since that is the case, Examiner has not made the *prima facie* case of obviousness required by MPEP 2143. These claims are consequently patentable in their own rights over Telemedicine and Abrahamson.

Conclusion

A check in the amount of \$395.00 for the fee for the RCE and a check in the amount of \$60.00 for a one-month extension of time to reply to the final rejection mailed 7/5/2006
 5 accompany this Submission. Applicants have thereby satisfied the requirements of 37
 C.F.R. 1.114 and 1.136 and respectfully request that Examiner withdraw the finality of the
 rejection of 7/5/2006, enter the amendment to the claims set forth in the submission, and
 again consider Applicants' traversal of the rejection of 7/5/2006.

10 Respectfully submitted,

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20 Date

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